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1. AMENDMENT AFTER FINAL REJECTION 09/340,303
3 pages
 2. REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION
15 pages 09/340,303
- 19 PAGES TOTAL —

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of FREDRIC GOLDSTEIN)
)
Serial No.: 09/340,303) **Examiner: KIM, EUGENE LEE**
)
Filing Date: 06/28/99) **Art Unit: 3721**

Title: RIBBON CURLING AND SHREDDING DEVICE

Honorable Commissioner of Patents and Trademarks,
Washington, DC 20231

18 November, 2004

AMENDMENT AFTER FINAL REJECTION

Dear Sir,

Please amend the application as follows:

IN THE CLAIMS:

Claim 26, 28-33 are cancelled without prejudice. Please amend Claim 27,
34-37 as follows:

27. A ribbon curling device comprising:

Delivery means for delivering a supply of unstressed curtable ribbon;
curling means located downstream of said delivery means for curling said ribbon;

Mechanical drive means selected from the group consisting of conveyor
belts, rollers and wheels;

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Honorable Commissioner of Patents and Trademarks,
Washington, DC 20231

November 18, 2004

**REQUEST FOR RECONSIDERATION
AFTER FINAL REJECTION**

Dear Sir:

In response to the Office Action dated August 18, 2004, Applicant respectfully requests reconsideration of the above-referenced application and formally requests an interview with both the Examiner and SPE. Pursuant to § 713.09, these remarks form the basis of the intended purpose and content of the interview.

Applicant requests that the supervisory patent examiner take part in the interview, pursuant to MPEP 07.02 Applications Up for Third Action and 5-Year Applications [R-2] ["Any application that has been pending five years should be carefully studied by the supervisory patent examiner and every effort >should be< made to terminate its prosecution. In order to accomplish this result, the application is to be

considered "special" by the examiner."] The instant application was filed in June 1999 and has now been pending in excess of five years.

Applicant respectfully believes that the Office Action issued on August 18, 2004 contains misconceptions of fact and law and a misunderstanding of the prior art, applicant's invention, and applicant's arguments. Applicant is also disconcerted that a detailed Remarks section filed in response to the prior Office Action (see enclosed August 25, 2003 response by Applicant) appears cursorily read as it was utterly ignored (save for a remark disagreeing, without explanation, that a reference teaches away from the invention). The Examiner simply copied and pasted identical language from the April 25, 2003 Office Action in repeating the same basic obviousness rejection. The assertion under paragraph 3. of the Office Action that Applicant's arguments are moot "in view of the new ground(s) of rejection" is cryptic since independent claims 26 and 27 are rejected with near identical grounds (the only difference being the inapposite *Schreiber* citation, see *infra*).

Pursuant to MPEP 707.07(j) State When Claims Are Allowable [R-2], an Examiner should issue constructive Office Actions which fully consider the Applicant's arguments, especially when the applicant is *pro se*.

I. < INVENTOR FILED APPLICATIONS

When, during the examination of a *pro se* application it becomes apparent to the examiner that there is patentable subject matter disclosed in the application, the examiner should draft one or more claims

for the applicant and indicate in his or her action that such claims would be allowed if incorporated in the application by amendment.

This practice will expedite prosecution and offer a service to individual inventors not represented by a registered patent attorney or agent. Although this practice may be desirable and is permissible in any case deemed appropriate by the examiner, it will be expected to be applied in all cases where it is apparent that the applicant is unfamiliar with the proper preparation and prosecution of patent applications.

II. < ALLOWABLE EXCEPT AS TO FORM

When an application discloses patentable subject matter and it is apparent from the claims and applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and, when possible, should offer a definite suggestion for correction. Further, an examiner's suggestion of allowable subject matter may justify indicating the possible desirability of an interview to accelerate early agreement on allowable claims.

The Examiner failed to consider the application as containing potentially patentable subject matter before issuing the final rejection.

CLAIMS 26-27 REJECTION

The final rejection itself was flawed in fact and law. The Examiner failed to consider MPEP 2141 35 U.S.C. 103; the Graham Factual Inquiries (35 U.S.C. 103 Conditions for patentability; non-obvious subject matter) and failed to address, much less explain, where the prior art teaches or motivates the skilled man in the art to make the combination suggested by the Examiner.

MPEP 2143.01 "Suggestion or Motivation To Modify the References [R-2]" states:

**FACT THAT REFERENCES CAN BE COMBINED OR
MODIFIED IS NOT SUFFICIENT TO ESTABLISH *PRIMA
FACIE* OBVIOUSNESS**

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

This chapter then goes on to state that "Although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.' 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992)".

The Examiner did not articulate any reasoning as to why a skilled man in the art, when confronted with the problem of curling ribbon on a mass production basis, would look to a package wrapping machine (Focke) and add a particular structure from that machine to a cigarette making machine (Hinzmann). Simply reciting particular elements present in the prior art references, without any suggestion or motivation to combine those structures to solve the problem addressed by the inventor, is impermissible hindsight. A skilled man in the art seeking to conceive of a drive means to insure non-disrupted operation, whereby the drive means draws the ribbon but will release it so as to prevent jamming, would not look to a package wrapping device Focke which does not deal with handling a *curled* web. The Examiner employs the false assumption that a curled web and a straight flat web are essentially the same and

thus would present the same problems to be solved. Moreover, the substitution of opposing conveyor belt drive means for rollers in Hinzmann would render that device inoperable. See MPEP 2143.01 ("THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE: If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious, citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). See also MPEP 2143.01 ("THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)”)

In attempting to deal with unwieldy curled static-charged ribbon, a man of ordinary skill in the art would not look to a package wrapping device to find a suitable drive means. Conveyor belts are long and more likely prevent the curled ribbon from curling around the conveyor belt and jamming, as it would more readily do with simple rollers. The Examiner does not explain how the use of conveyor belts as a superior drive means for curled ribbon would be an obvious substitution for the man of ordinary skill in the art. The prior art Focke recited by the Examiner lacks both the structure and function of

the instant invention, therefore even if it were an obvious substitution, which it is not, would not solve the problem addressed by the Applicant nor function for the intended purpose. The Focke device employs conveyor belts which are firstly laterally disposed, not opposing, and secondly, to transport the severed flat blank for wrapping the package. There is nothing in Focke which would suggest to the skilled man in the art that it would function better than mere conventional wheels or rollers since Focke deals exclusively with a flat square or rectangular blank, not lengthy strands of curled and static charged ribbon. The purpose of Focke is, contrary to the instant invention, to keep the web flat and straight, and avoid any folds or curls, as it transports it towards the packaging area and allow for a package to be placed so as to allow wrapping it with the blank. Adding the opposing conveyor belt to Focke would render it inoperable since the package could not be placed on the blank (the core problem addressed by Focke). Thus it teaches away from handling *curled* web material with opposing belts or rollers (see August 25, 2003 Remarks section for detailed argument).

Additionally, the Examiner's rejection of claims 26-27 was factually incorrect and case law misapplied. The Examiner cites *In re Schreiber*, 128 F.2d 1473, 1477-78, 44 USPQ2d 1429, 1431-1432 (Fed Cir 1997). This case is inapposite however since it relates to anticipation, not to the Examiner's obviousness rejection, e.g. the issues of anticipation, where all the claim elements are present in a single prior art reference, is different than obviousness, where there must be some teaching or motivation to combine two or more prior art references. See *Elan Pharmaceuticals v Mayo* (Fed Cir 2002)

("Anticipation is a question of fact, as is the question of inherency. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). Its proof differs from that for obviousness, 35 U.S.C. §103[.].").

Schreiber teaches that:

A patent applicant is free to recite features of an apparatus either structurally or functionally. See In re Swinehart, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971) ("[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims."). Yet, choosing to define an element functionally, *i.e.*, by what it does, carries with it a risk. As our predecessor court stated in Swinehart, 439 F.2d at 213, 169 USPQ at 228:

where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

See also In re Hallman, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981); In re Ludtke, 441 F.2d 660, 663-64, 169 USPQ 563, 565-67 (CCPA 1971).

Applicant respectfully suggests that the Examiner never considered this aspect of defining an element functionally, having summarily rejected Applicant's right to prove that the prior art relied upon by the Examiner "does not possess the characteristic relied on" (*id.*). Indeed, as the Federal Circuit explained in *Schreiber*:

At that point, the burden shifted to *Schreiber* to show that the prior art structure did not inherently possess the functionally defined limitations of his claimed apparatus. See In re Spada, 911 F.2d at 708, 15 USPQ2d at 1658; In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138-39 (Fed. Cir. 1986); In re Best, 562 F.2d 1252, 1254-55, 195 USPQ 430, 433 (CCPA 1976).

That said, the function of the structure is unquestionably a critical element in the § 103 analysis for the motivation to combine and/or as to whether there is any teaching in the prior art to suggest such combination. By way of obvious example, rollers used in a printing press (function being a delivery means for ink) would not suggest the use of rollers for drive means (function being to move a web material) and thus a § 103 rejection using a printing press (e.g. its rollers) in combination with other prior art would be improper. The Examiner's statements contrary to this basic tenet of patent law is respectfully believed to be erroneous. As stated *supra*, anticipation requires a different analysis than obviousness and the two cannot be jumbled together.

Indeed, *Schreiber* peripherally dealt with the obviousness issue and confirms that functionality, contrary to the Examiner's assertion, is a part of the obviousness analysis:

Schreiber also challenges the Board's finding that claims 2 and 15 are unpatentable under 35 U.S.C. §103 as being obvious over the combination of Harz and Fisher. Schreiber argues that the combination of Harz and Fisher does not disclose all the limitations of claim 2 because neither Harz nor Fisher discloses the functionally defined features of the top. That argument is without merit because, as we have already noted, Harz discloses those functionally defined limitations.

Focke does not describe the functionally defined limitations of ribbon disposed between the conveyor belts to draw a curled ribbon strand. Additionally, *Schreiber* allows for functions to traverse prior art if recited as part of the means-plus-function language of the claim:

Schreiber also argues that Fisher does not provide the function that the "means for closing off" in Schreiber's application provides. The functions Schreiber cites – enabling a person to carry a popped- popcorn package in a non-upright position without spillage, keeping the popcorn warm, and facilitating the mixing of ingredients – are not recited as part of the means-plus-function clause in claim 2. Accordingly, those functions cannot impart patentability to the claim.

A cursory reading of the initial paragraphs of the Focke specification confirms the problem to be solved in Focke is non-analogous to the instant invention e.g. an unopposed conveyor belt designed to hold a flat blank of paper for further wrapping around a package. As fully described in the detailed August 25, 2003 Remarks, Focke unquestionably teaches away from the use of its conveyor belts in the instant invention. The Examiner's rejection of this argument appears to be solely versed in the misapplication, *supra*, of the importance of function when examining obviousness and the motivation to combine. If any prior art reference could be combined due to the mere presence of a shared element found in the claim of the pending application, there could not be any issue of teaching or suggestion to combine with other elements in other prior art references- simply having all the elements found in multiple prior art references, regardless of the function, would suffice to render an invention obvious. It is axiomatic, however, that nearly every mechanical invention is a combination of old and known elements. Clearly, teaching and suggestion refers to the *use and function* of the structure recited, e.g. how the prior art structure is used and/or the teachings and the nature of the problem to be solved. How each element was used in the prior art is, in fact, of critical importance in any obviousness inquiry.

More importantly in the instant application, the Examiner's recited structure of the Focke device has neither the function *nor the structure* of the instant invention. The rollers of the Focke invention are not in contact with the conveyor belts and thus no "pairing" can be said to exist. Critically, the Focke conveyor belts are not opposing each other, such that the ribbon is "disposed" between the said combination or pairing, as recited in claim 26 and 27 of the instant application. The Focke belts in fact are merely a single dual band conveyor belt; they are parallel to each other and drive the web blank by use of suction causing the web to adhere to the belts. There is no opposing belt nor pair or combination as claims 26 and 27. Thus the Focke structure as well as the function of the conveyor belts are different. This is detailed in the August 25, 2003 Remarks.

Moreover, Focke is non-analogous art. See Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH, 193 F.3d 877, 45 U.S.P.Q. 2d 1977 (Fed. Cir. 1998) ("To ascertain the scope of the prior art, a court examines "the field of the inventor's endeavor," Shatterproof Glass Corp. v. Libbey-Owens Ford Co., 758 F.2d 613, 620, 225 USPQ 634, 638 (Fed. Cir. 1985), and "the particular problem with which the inventor was involved," Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1535, 218 USPQ 871, 876 (Fed. Cir. 1983) (quoting In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979)), at the "time the invention was made," see 35 U.S.C. § 103(a).") Nothing in the problem to be solved in the instant invention, e.g. to curled ribbon on a mass production basis, would direct a skill man in the art to a package wrapping

machine which handles solely a flat non-curved blank. It is not pertinent to the particular problem the Applicant attempted to solve. See MPEP 2143

(IX. ARGUING THAT PRIOR ART IS NONANALOGOUS- A prior art reference is analogous if the reference is in the field of applicant's endeavor or, if not, the reference is reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

Nor is the mere use of a conveyor belt (unopposed) in prior art relevant if the problem to be solved by the conveyor belt differs from the Applicant's invention.

See also MPEP 2141.01(a) ANALOGY IN THE MECHANICAL ARTS

See, for example, *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992) (Applicant claimed an improvement in a hose clamp which differed from the prior art in the presence of a preassembly "hook" which maintained the preassembly condition of the clamp and disengaged automatically when the clamp was tightened. The Board relied upon a reference which disclosed a hook and eye fastener for use in garments, reasoning that all hooking problems are analogous. The court held the reference was not within the field of applicant's endeavor, and was not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. The Commissioner further argued in the brief on appeal that a disengageable catch is a common everyday mechanical concept, however the court held that the Commissioner did not explain why a "catch" of unstated structure is such a concept, and why it would have made the claimed invention obvious.).

In any event, Applicant feels the Examiner has misinterpreted both the nature and reasoning behind the amendment addition of "tractive pull". This was

simply added to clarify the function of the drive means in the instant application, not to traverse any prior art. The claim limitation of opposing pairs of belts and/or rollers is to insure sufficient tractive drive to pull the ribbon through the machine. A single belt or roller, without an opposing structure, may only function as a passive transport means if the drag on the material to be worked upon is great enough.

CLAIMS 28-37 REJECTION

Applicant also disputes the Examiner's rejection of claims 28-37 on multiple grounds. Firstly, Goldstein teaches guide means to control the approach angle to the *curling means* only. It does not relate whatsoever to the approach angle of the ribbon to the mechanical *drive means*, as recited in claims 28, 33 (Goldstein is of course directed to manual ribbon curling and absent any mechanical drive means). As such, a blanket rejection of the dependent claims is improper.

As to the rejection of claims 29 and 34, Applicant submits that all three prior art references address such different problems that a skilled man in the art would not look to these three patents which solve three entirely different problems to solve the problem of mass production of curled ribbon (the *Goldstein '417* patent only deals with manual pulling of ribbon, e.g. not mass production). Again using the invention as a road map, the Examiner has cherry picked the elements in the claims and, not surprising given that all the elements are old and known, found three prior art references which together contain all the elements. However, Applicant is patenting the unique combination of the elements.

It is noteworthy that Examiner Kim is the primary examiner of record in a continuation US patent no. 6,261,216 in the same family (sharing the same specification as the instant application). Claim 3 recites means to vary the approach angle of the ribbon to the curling means.

As to the rejection of claims 30, 31, 35, and 36, the same aforementioned continuation patent contains three independent claims which recite claim limitations related to the material of the product to be worked upon (color). The material which the apparatus is to work upon is in fact critical to obviousness (while again the analysis for anticipation, where material would not impart patentability, may be improperly included). An invention directed to work upon a pliable web material would improperly be deemed obvious by reference to prior art for which the apparatus works upon hardened steel. The problems to be solved in working upon the material at hand directly addresses the motivation and/or teaching to combine prior art references. Applicant believes again that Examiner's rejection is more properly based on an anticipation rejection (where different function and/or material is irrelevant) than an obviousness rejection. There is no prior art reference that contains all the elements of independent claim 27 whereby the inclusion of material in a dependent claim would allegedly address patentability. Additionally, there is no additional "inclusion of material or article worked upon" in this claim *per se*, since the article "curlable ribbon" is already properly included in the independent claim, merely the composition of the ribbon (polypropylene) better defines (and narrows) the article to be worked upon. That

said, the claim is amended herein to modify in effect the structure of the delivery means as delivering the respective material.

Applicant acknowledges that claims 32 and 37 should be in a definitive form affirming a structure, rather than the possibility for a structure. While Applicant believes the Examiner could have suggested the simple removal of "may" to place the claim in allowable form, Applicant has now amended this claim herein.

SECONDARY FACTORS

Obviousness rests on several critical factual underpinnings: (1) the scope and content of the prior art, (2) the differences between the prior art and the claimed invention, (3) the level of skill in the art, and (4) the objective indicia of nonobviousness. See Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1566-67, 1 USPQ2d 1593, 1595-96 (Fed. Cir. 1987); Graham v. John Deere Co., 383 U.S. 1, 17 (1966).

It has been confirmed by the Federal Circuit in *Group One, Ltd v. Hallmark Cards, Inc.*, 254 F.3d 1041 (Fed. Cir. 06/15/2001) that until the instant invention, curling ribbon was sold in its pre-curved state.

Prior to Goldstein's conception, ribbon had been sold in a form that was suitable for curling, but was not so curled until curled by the consumer. Goldstein perceived a market for pre-curved ribbon-for use, for example, as filler in a gift package or gathered in a bow-and conceived the inventions of the '492 patent and '752 patent to exploit that market.

Secondary factors, often referred to as objective indicia of non-obviousness, are probative of non-obviousness. The failure of others to have conceived of a mass production curling machine during the prior 30 years of *billions* of dollars of "curling ribbon" (polypropylene ribbon) sold world-wide as flat plastic to be curled manually by the consumer weighs heavily towards non-obviousness. Commercial success and long felt need, two additional secondary factors, is borne out by the approximate one billion dollars in retail sales of pre-curved ribbon products since its introduction in 1995 (a majority of which are mass produced by machine).

Applicant submits that he has made a diligent effort to place the application in condition for allowance and/or better condition for appeal. More importantly, Applicant believes that through an Interview, any remaining rejections, if any, could be dealt with to allow for a Notice of Allowance. Applicant can be reached at e-mail address: fgoldstein@grouponelimited.com

Respectfully submitted,



Fredric Goldstein

Pro se Applicant as Inventor of record

Date: November 18, 2004

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